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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,356

03/18/2005

Francis Marsais

0600-1038

5020

466

7590

01/14/2009

YOUNG & THOMPSON

209 Madison Street

Suite 500

ALEXANDRIA, VA 22314

EXAMINER

VALENROD, YEVGENY

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

01/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,356	Applicant(s) MARSAIS ET AL.	
	Examiner YEVEGENY VALENROD	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-32 is/are pending in the application.
- 4a) Of the above claim(s) 14-21 and 27-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/20/05; 3/18/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a first office action on the merits in application # 10/528,356.

This application has been transferred to Examiner Valenrod whose contact information is provided at the end of the instant document.

Election/Restrictions

Applicant's election with traverse of Group II, in the reply filed on 10/10/08 is acknowledged. The traversal is on the ground(s) that the listed inventions do not lack unity of invention. This is not found persuasive because the common technical feature of the inventions is the polycarboxylic acid comprising composition which has been described in the art (see rejection of claim 22 below). In view of applicants' argument, group II (claims 22-25) and group III (claim 26) are hereby rejoined. Group I, the method of preparing the composition of claim 22 can be potentially rejoined with the elected composition claims once allowable subject matter in the elected group has been identified. Claims 22-26 are hereby examined on the merits.

The requirement is still deemed proper and is therefore made FINAL.

Claims 14-21 and 27-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subject matter, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/10/08.

Objection to specification

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The abstract of the disclosure is objected to because the priority information does not appear in the first paragraph of the specification. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 22-25 require ability to be made by the process of claim 14. However, claim 14 fails to specify which monosaccharide(s) would produce the claimed compositions.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

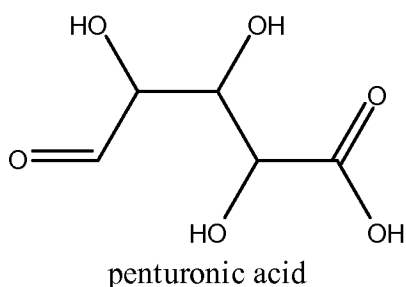
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Tisza et al (*Abstract of Journal of Chromatography*, A **1994**, 676(2), 461-468).

Tisza et al disclose glucaric acid (last acid listed in the abstract). Glucaric is a polycarboxylic acid that can be obtained from monosaccharide using the method of the instant claim 14.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Fuchs et al (Abstract of Ustrasonics Sonochemistry 1995, 2(2) s105-s109).

Fuchs et al disclose Penturonic acid which has the following structure:



Penturonic acid is a derivative of 2-carboxy-2,3,4-trihydroxypentanedioic acid. The term derivative has not been provided with a limiting definition by the specification and is given the broadest reasonable interpretation.

Allowable Subject Matter

Claims 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 23-25 comprise limitations directed either a specific polycarboxylic acid being present in the composition or a ratio of carboxylic di and tri acids being present in the composition. Search of prior art did not

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uncover any references to 2-carboxy-2,3,4-trihydroxypentanedioic acid. Compositions comprising said acid are therefore free of art. Search of prior art has also failed to uncover compositions comprising 30-90% of diacid and 3-59% triacid that can be prepared from a monosaccharide comprising composition.

Conclusion

Claims 14-32 are pending

Claims 14-21 and 27-32 are withdrawn

Claims 22-26 are rejected

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yevgeny Valenrod/

Yevgeny Valenrod
Patent Examiner
Technology Center 1600

/Paul A. Zucker/
Primary Examiner, Art Unit 1621